



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/747,742

12/29/2003

Mark Tawa

TPI-2900C3XC2

2066

23557 7590 11/15/2007
SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO BOX 142950
GAINESVILLE, FL 32614-2950

EXAMINER

ISSAC, ROY P

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,742

Applicant(s)

TAWA ET AL.

Examiner

Roy P. Issac

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Applicant's amendment/ remarks/ response filed 9/04/07, wherein all pending claims have been cancelled and claims 7-31 have been newly submitted. Applicants' submission of new claims 7-31 necessitates requirement for restriction as set forth below.

This application claims benefit of 60/486,713 07/11/2003 and claims benefit of 60/459,501 04/01/2003 and claims benefit of 60/456,608 03/21/2003 and claims benefit of 60/456,027 03/18/2003 and claims benefit of 60/441,335 01/21/2003 and claims benefit of 60/437,516 12/30/2002 and is a continuation in part of 10/601,092 06/20/2003 abandoned which claims benefit of 60/390,881 06/21/2002 and claims benefit of 60/426,275 11/14/2002 and claims benefit of 60/427,086 11/15/2002 and claims benefit of 60/429,515 11/26/2002 and claims benefit of 60/437,516 12/30/2002 and claims benefit of 60/456,027 03/18/2003 and is a CIP of PCT/US03/19574 06/20/2003 which claims benefit of 60/390,881 06/21/2002 and claims benefit of 60/426,275 11/14/2002 and claims benefit of 60/427,086 11/15/2002 and claims benefit of 60/429,515 11/26/2002 and claims benefit of 60/437,516 12/30/2002 and claims benefit of 60/456,027 03/18/2003 and said 10/601,092 06/20/2003 claims benefit of 60/390,881 06/21/2002 and claims benefit of 60/426,275 11/14/2002 and claims benefit of 60/427,086 11/15/2002 and claims benefit of 60/428,515 11/22/2002 and claims benefit of 60/437,516 12/30/2002 and claims benefit of 60/456,027 03/18/2003

This application 10/747,742 is a CIP of PCT/US03/19574 06/20/2003 which claims benefit of 60/390,881 06/21/2002 and claims benefit of 60/426,275 11/14/2002 and

Art Unit: 1623

claims benefit of 60/427,086 11/15/2002 and claims benefit of 60/429,515 11/26/2002 and claims benefit of 60/437,516 12/30/2002 and claims benefit of 60/456,027 03/18/2003 This application 10/747,742 is a CIP of PCT/US03/41273 12/24/2003 which is a CIP of 10/601,092 06/20/2003 ABN which claims benefit of 60/390,881 06/21/2002 and claims benefit of 60/426,275 11/14/2002 and claims benefit of 60/427,086 11/15/2002 and claims benefit of 60/429,515 11/26/2002 and claims benefit of 60/437,516 12/30/2002 and claims benefit of 60/456,027 03/18/2003 and said PCT/US03/41273 12/24/2003 is a CIP of 10/660,202 09/11/2003 which is a CIP of PCT/US03/27772 09/04/2003 which is a CIP of 10/378,956 03/03/2003 which claims benefit of 60/360,768 03/01/2002 and said PCT/US03/27772 09/04/2003 claims benefit of 60/451,213 02/28/2003 and claims benefit of 60/463,962 04/18/2003 and claims benefit of 60/487,064 07/11/2003 and said 10/660,202 09/11/2003 is a CIP of 10/637,829 08/08/2003 which is a DIV of 10/295,995 11/18/2002 PAT 6,699,840 and said 10/295,995 is a CON of 10/232,589 09/03/2002 PAT 6,559,293 which claims benefit of 60/406,974 08/30/2002 and claims benefit of 60/380,288 05/15/2002 and claims benefit of 60/356,764 02/15/2002 and said 10/660,202 is a CIP of 10/449,307 05/30/2003 PAT 7,078,526 which claims benefit of 60/463,962 04/18/2003 and claims benefit of 60/444,315 01/31/2003 and claims benefit of 60/439,282 01/10/2003 and claims benefit of 60/384,152 05/31/2002 and said 10/660,202 is a CIP of 10/601,092 06/20/2003 ABN and claims benefit of 60/451,213 02/28/2003 and claims benefit of 60/463,962 04/18/2003 and claims benefit of 60/487,064 07/11/2003.

Art Unit: 1623

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 7 in part and claims 8-13, drawn to a solvate of olanzapine, classified in class 514, subclass 220, and class 540, subclass 557 for example.
- II. Claim 7 in part and claims 14-19, drawn to a solvate of cortisone, classified in class 424, subclass 115.
- III. Claim 7 in part and claims 20-25, drawn to a solvate of naproxen, classified in class 562, subclass 466, and class 514, subclass 428 for example.
- IV. Claim 7 in part and claims 26, drawn to a solvate of celecoxib trihydrate, classified in class 514, subclass 406 and class 548 and subclass 356 for example.
- V. Claim 7 in part and claims 27-31, drawn to a solvate of celecoxib, classified in class 514, subclass 406 and class 424 subclass 484 for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and V are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are separate and distinct from each other since the pharmaceuticals in each Group above are involved in various, many possible and

Art Unit: 1623

different and separate and chemical structure, function and use. Therefore, they have different modes of operation and different functions.

Each compound claimed herein have distinct structural features and art recognized use in divergent pharmaceutical fields. As such, the search for each distinct compound will place an undue burden on the examiner.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claim 7 link(s) inventions I-V. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 7. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim,

Art Unit: 1623

such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement

Art Unit: 1623

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


Because the above set forth restriction/election requirement is complex, a telephone call to applicant's agent to request an oral election was not made. See MPEP § 812.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy P. Issac whose telephone number is 571-272-2674. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roy P. Issac
Patent Examiner
Art Unit 1623


S. Anna Jiang, Ph.D.
Supervisory Patent Examiner
Art Unit 1623